

REMARKS

This is a preliminary amendment in the continuation of Application No. 09/901,220, which was appealed to the Board of Appeals. By this amendment, claims 1-36 in the application as filed are hereby canceled, and new claims 37-101 are entered.

In the Board of Appeals decision in the prior case, mailed January 30, 2004, the Board reversed on claim 65, stating that claim 65 specifically requires **“folding and gluing the seam to capture the radio frequency identification tag within the glued portion of the seam.”** Concerning the issue is depositing the RFID tag in proximity to a seam, the Board further states: **“claim 65 nevertheless requires that the folding and gluing steps result in the tag being captured within the glued portion of the seam.”** Claim 65 was subsequently allowed by the Examiner.

The Applicants' invention as recited in the pending claims is a method for manufacturing document storage containers, such as a file folders, file boxes, file pockets, or x-ray jackets, in which a radio frequency identification tag (RFID) is be embedded into the folder during the manufacturing process. None of the prior art cited during the prosecution of the previous application teaches or suggests the manufacture of file folders with RFID tags embedded within the folder during the process of their manufacture, by folding and gluing the seam to capture the radio frequency identification tag within the glued portion of the seam. Product claims 90-100 and process of using claim 101 are also included as specifically provided for by 37 CFR §1.141(b) and MPEP 806.05(i).

New Claims 37-56

New claim 37 recites a method of manufacturing document storage containers including the steps of die cutting a blank document container from document container stock; positioning an RFID tag on the blank document container stock in proximity to a seam; folding and gluing the seam to capture the RFID tag within the glued portion of the seam; and folding and gluing

the document storage container to form a completed document storage container. This claim is supported in the specification as filed herewith from page 38, line 13 to page 39, line 13. The limitations of claim 37 are similar to the limitations of claim 65 in Application No. 09/901,220, which was reversed on appeal, and subsequently allowed.

Claims 38-57 all depend from 37 and recite the structure of the captured radio frequency identification tags, as well as various types and uses of the claimed document storage containers, such as printing on the manufactured document storage container from a computer database. Dependent claims 38-56 include the limitations of independent claim 37 and are therefore clearly allowable. Early allowance is requested.

New Claims 57-65

New claim 57 recites a method of manufacturing trackable document storage containers including the steps of die cutting a blank document container from document container stock; depositing an RFID tag on the blank document container stock in proximate to a seam; applying glue to the area of the seam; and folding and gluing the seam to capture the RFID tag within the glued portion of the seam to form a complete document storage container. This claim is supported in the specification as filed herewith from page 38, line 13 to page 39, line 13. Again, the limitations of claim 57 are similar to the limitations of claim 65 in Application No. 09/901,220, which was reversed on appeal, and subsequently allowed.

Claims 58-65 all depend from 57 and recite the writing identification information into the RFID tag, as well as printing bar coding information during the manufacture of the document storage container. Dependent claims 58-65 include the limitations of independent claim 57 and are therefore clearly allowable. Early allowance is requested.

New Claims 66-88

New independent claim 66 with dependent claims 67-88 recite a method of manufacturing a trackable document storage container with improved security features. In this

claimed embodiment, the location of the RFID tag in a first manufactured document storage container is different than the location of an RFID tag in a second manufactured document storage container. Since the RFID reader need only be in close proximity to the storage container it is reading, it is a simple matter and well within the scope of the present invention to position the RFID tags in different locations in the document storage containers for different production runs to increase the security features provided. Since an RFID tag, captured within the glued seams of the document storage container, is not visible and it's location in the storage container is not known, the RFID tag cannot be removed, and this ensures that the RFID tracking features cannot be easily circumvented.

Claims 67-88 all depend from 66 and various types and uses of the claimed document storage containers as well as the structure of the radio frequency identification tags. Dependent claims 67-88 include the limitations of independent claim 66 and are therefore clearly allowable. Early allowance is requested.

New Claims 89

New independent claim 89 recites a method of manufacturing trackable document storage containers, where the RFID tag is permanently captured in the folding and gluing process at a predetermined location. The recited method includes the steps: die cutting a first blank document container from document container stock; positioning a passive radio frequency identification tag on the document container stock in a predetermined location proximate to a seam; and folding and gluing the document container stock to permanently capture the radio frequency identification tag at the predetermined location. The claim limitations in independent claim 89 are consistent with the Board of Appeals decision and early allowance is requested.

New Claims 90-100

New independent claim 90 with dependent claims 91-100 recite a document storage container manufactured by the process for manufacturing document storage containers recited in

independent claim 37 and dependent claims 41-50. Claim 90 recites a document storage container for storing documents comprising a die cut document container blank folded and glued to form an enclosure for containing documents; the document container having at least one folded and glued seam; and a radio frequency identification tag captured within the glued portion of the seam.

The product made is not distinct from the process of making, since the process claimed in claim 37 and dependent claims 41-50 are specifically for manufacturing the products claimed in independent claim 90 and dependent claims 91-100. In this case, the product and process claims are proper in a single patent application, since there is no alternative manufacturing process that may be used to produce the document storage container of claim 90. Claims 90-100 are therefore clearly allowable and early allowance is requested. Product claims 90-100 corresponding the process claims 37, 41-50 are provided for by 37 CFR §1.141(b) and MPEP 806.05(i).

New Claim 101

New independent claim 101 recites a method of tracking document storage containers transported from a first location to a second location in a storage facility using radio frequency identification readers embedded in a doorway detection system or portal and the shelf manager system 10 of the present application. Claim 101 is supported in the specification as filed herewith from page 38, line 13 to page 39, line 13 and also by FIG. 43. Claim 101 is a process of using claim for the method claims 37, 41-50, and for the corresponding product claims 90-100, and recites document storage containers including RFID tags captured within the folded and glued seam of the containers for storing identification information. Process of using claim 101 is provided for by 37 CFR §1.141(b) and MPEP 806.05(i). As a process of using claim, it is therefore properly included in the same application and early allowance is requested.

Conclusion

In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. Should further questions arise concerning this application, the Examiner is invited to call the Applicants' representative at the number listed below.

Respectfully submitted,
Arthur C. Fitzgerald

By: Kenneth L. Milik

Kenneth L. Milik
Agent for Applicant
Registration No. 30,963

Kenneth L. Milik
143 Martin Street
Carlisle, MA 01741
Telephone No. (978) 371-0102
Fax No. (978) 371-1791
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